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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,158

12/02/2003

Francis Ford Coppola

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12/13/2006

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EXAMINER

WEIER, ANTHONY J

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,158

Applicant(s)

COPPOLA, FRANCIS FORD

Examiner

Anthony Weier

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 5-13 and 15-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I (claims 1-4 and 14) in the reply filed on 9/21/06 is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the recitation "low calorie" is indefinite in that it cannot be discerned as (as to the scope of the claims) when a tofu is an isn't low in calories. In other words, what is "low" in calories may not be to another.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomita et al or JP 59-55161 taken together with Meyer et al (U.S. Patent No. 6242032), any one of JP 62-269657, JP 59-198950, and Parada et al, and any one of Meyer et al (U.S. Patent No. 6187357), Seltzer, and Yoshida et al.

Tomita et al discloses a pasta product (e.g. noodle, an "other pasta type" as called for in instant claims 14) comprising tofu, flour, egg (inherently including egg whites), and salt (e.g. col. 4).

JP 59-55161 discloses a pasta product (e.g. noodle) comprising tofu (i.e. bean curd), flour, egg (inherently containing egg white), and salt.

The instant claims further call for the presence of potatoes, and more specifically, mashed potatoes. It should be noted that both Tomita et al and JP 59-55161 further disclose the use of yams. Yams are similar to potatoes and have been used as alternates in the preparation of noodles as taught, for example, by Meyer et al "032 (e.g. claim 8). It would have been obvious to one having ordinary skill in the art at the time of the invention to have employed potato in place of yam in Tomita et al as a known alternative ingredient in the preparation of noodles. In addition, the inclusion of mashed potatoes in noodle making is notoriously well known. For example, JP 62-269657 teaches the inclusion of mashed potatoes in noodles to provide Vitamin C. JP 59-198950 teaches the inclusion of mashed potatoes in noodles to provide a potato flavor to the product. Parada et al teaches prior art use of mashed potatoes in noodle making as a matter of convention (e.g. col. 1, lines 47-61). It would have been further obvious to have included same as a matter of preference depending on, for example, the flavor desired in the final product or the desire for Vitamin C or to have simply incorporated same as a matter of convention.

It should be noted further that Tomita et al discloses the use of any ingredient additional ingredient as long as it is normally used in noodles (col. 4, lines 3-10).

However, sodium bicarbonate is a well known component in the noodle-making art. For example, Meyer et al ' 357 teaches the same to provide a more porous noodle (e.g. col. 4, lines 10-16). Seltzer teaches the use of sodium bicarbonate in making noodles wherein same is employed as part of a leavening agent (e.g. col. 2, lines 57-64).

Yoshida et al includes sodium bicarbonate in preparing noodles wherein same is used in a conditioner mixture that enhances the elasticity, expandability, and texture of said noodles (col. 2, lines 31-38). It would have been further obvious to have incorporated sodium bicarbonate in the product of Tomita et al for such reasons.

With respect to claim 2, although the tofu employed in making the product is a puree of tofu, the end product would include a product with a firm texture. It is not seen wherein the use of a puree or solid form of tofu would make for a patentable distinction in the end product as both undergo a mixing and melding with other ingredients during production. Also, due to the indefinite meaning of the term "low calorie" in claim 2, the tofu in Tomita is inherently low in calories.

Claims 3 calls for the use of mashed potatoes that have originated from baked potatoes. Baked potatoes are a notoriously well known prepared form of potato and a potato form which is used in the preparation of mashed potatoes (e.g. potato filling of twice-baked potatoes). It is not seen where the use of baked potatoes in preparation of mashed potatoes to be used in noodle-making would make for a patentable distinction, and it would have been further obvious to have employed such source of potato as a matter of preference depending on, for example, time constraints and available equipment in preparing the potato ingredient.

The claims further call for the particular amounts of each component to be used. However, such determination would have been well within the purview of a skilled artisan, and it would have been further obvious to have arrived at such amounts as a result effective variable. Knowing that an ingredient will cause a certain result (flavoring, leavening, etc.), one would specifically measure the result and control the amount of ingredient added thereto in relation to the amount of said result desired. In re Skoner, 186 USPQ 80.

It is not seen where the ingredients as set forth in the claims would provide for a patentable distinction, and motivation for including all of same has been provided above. New recipes which involve the addition or elimination of common ingredients, or treating them in ways which differ from former practice, do not amount to invention merely because it is not disclosed that no one else ever did what applicant did. Applicant must establish coaction or cooperative relationship between said ingredients which products new, unexpected, and useful function. IN re Levin, 84 USPQ 232.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied above and further in view of JP 9-322728 and JP 60-153769.

If it is shown that the tofu of Tomita et al is not low in calories, it should be noted that it is well known to prepare tofu which is low in calories as taught, for example, by JP 9-322728, and it would have been obvious to one having ordinary skill in the art at the time of the invention to have employed same for the health benefit attributed to tofu having lowered calories by the removal of oil.

If it is shown that introducing tofu that is firm into the preparation of the product would provide for a significantly different product, the following should be noted. JP 60-153769 teaches the use of firm tofu in making noodles. Absent a showing of unexpected results, it would have been further obvious to have used firm tofu as a matter of preference among known alternatives.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

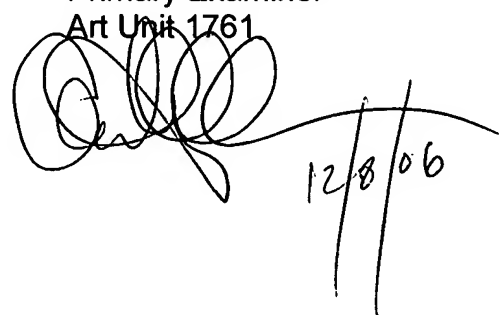
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anthony Weier
December 8, 2006

Anthony Weier
Primary Examiner
Art Unit 1761



12/8/06